

### REMARKS/ARGUMENTS

Reconsideration of this patent application is respectfully requested in view of the foregoing amendments, and the following remarks.

The claims are 1-4, 7 and 9. Claim 1 has been amended to more clearly define the invention, and claims 2-4, 7 and 9 have been amended to reflect the amendments to claim 1. Support for the amendments to claim 1 may be found, *inter alia*, in claims 1 and 6 as filed. No new matter has been introduced.

Claims 1-4, 7 and 9 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *U.S. Patent No. 5,552,573 to Okita et al.* Essentially, it is the Examiner's position that *Okita et al.* discloses a resistance welding process and apparatus substantially as recited in Applicants' pending claims with the exception of the metal strips being connected by rabbeting or stamping. In the Examiner's view, although *Okita et al.* does not disclose that the connections of the metal strips are by rabbeting or stamping, one of ordinary skill in the art would have recognized that these types of connections are similar in establishing a similar result as the clad welding process disclosed in *Okita et al.*, as all three of these types of

connections result in establishing a "bond " or "joining interface" between the two metal strips, thus suggesting the feature of the two metal strips being exclusively positively connected as recited in Applicants' claim 1. Moreover, in the Examiner's view, one of ordinary skill in the art would have found it "obvious to try" these various types of connections, since the Applicants were said to be choosing from a finite number of predictable solutions with a reasonable expectation of success in order to establish the predictable result of obtaining a joining interface between the metal strips.

This rejection is respectfully traversed and reconsideration is expressly requested.

As set forth in claim 1 as amended, Applicants' invention provides a device for protection of an electrode during resistance welding of workpieces. The device includes a strip placed over the electrode, a means for holding the strip over the electrode and a means for driving the strip. The strip includes a first metal strip made of a first material that is superimposed on a second metal strip that is made from a second and different material. The first and second metal strips are exclusively positively connected by rabbeting or stamping, such that the first metal strip is displaceable relative to the second metal

strip.

Okita et al. describes a device for protection of an electrode during resistance welding of workpieces that is substantially different than the device recited in Applicants' claims. Moreover, the device described in Okita et al. fails to achieve the advantages resulting from Applicants' claimed arrangement.

In particular, the device according to Okita et al. consists of an insert material (9) having a sheet-like core material (9a) and coated layers (9b, 9c) made of different materials than the core material. As noted by the Examiner at page 3 of the February 21, 2008 Office Action, the core material (9a) of Okita et al. is connected with the layers (9b, 9c) via metallic bonding. The strip protecting the welding electrode in Okita et al. is disposed between the electrode and the workpiece on each side of the workpieces to be welded. Each strip (9, 10) according to Okita et al. consists of one single strip with coated layers on each side.

The protection device according to Okita et al. does not teach or suggest a first metal strip superimposed on a second metal strip and exclusively positively connected by rabbeting or

stamping such that the first metal strip is displaceable relative to the second metal strip as recited in Applicants' amended claim 1. In particular, due to the metallic bonding between the strip (9) and the coating (9b, 9c) in *Okita et al.*, it is impossible for the core material (9a) and the coatings (9b, 9c) to be displaceable relative to each other. Therefore, it is impossible that the strips of the *Okita et al.* protecting device are displaceable relative to each other.

It is respectfully submitted that the different type of connection between the core material (9a) of the strip (9) and the coatings (9b, 9c) described in *Okita et al.* does not suggest the limitation "exclusively positively connected by rabbeting or stamping" as recited in independent claim 1 of the present patent application.

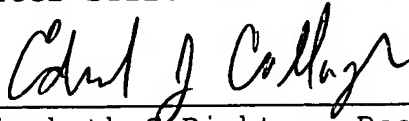
On the contrary, as set forth in amended claim 1, Applicants' invention provides an insert material or strip comprised of at least two superimposed metal strips made of different materials, wherein the metal strips are exclusively positively connected by rabbeting or stamping such that the strips are displaceable relative to each other. An example of such a connection is illustrated in FIG. 2 of the present patent application. With Applicants' claimed invention, it is possible to combine different materials for the optimum protection of the

welding electrode and provision of a high quality welding joint. In the protection device according to *Okita et al*, it is only possible to combine materials which form a metallic bonding between the core material and the coatings; however, with Applicants' claimed arrangement it is possible to combine different materials which cannot or cannot easily be connected with each other via metallic bonding. Accordingly, the device according to *Okita et al*. fails to achieve this significant advantage of Applicants' claimed arrangement.

Regarding the Examiner's arguments on page 4 and 5 of the February 21, 2008 Office Action, it is respectfully submitted that the Examiner's interpretation of *Okita et al*. is incorrect as the material (9) and core material (9a) cannot have differing localized speeds and cannot be displaceable relative to each other. The core material (9a) and the coatings (9b, 9c) according to *Okita et al*. cannot be displaced relative to each other, and therefore always have the same speed during transportation of the protecting device. The interpretation of the Examiner set forth on the last line of page 4 and the first line of page 5 of the Office Action is also believed to be in error, as the strip (9) further from the reel would be fed more quickly than the material closer to a reel, since the circumferential speed will increase with increasing distance from the center of the reel.

In summary, claims 1, 2-4, 7 and 9 have been amended. For the reasons set forth above, Applicants submit that claims 1-4, 7 and 9 are patentable over the cited reference. Early allowance of the claims is respectfully requested.

Respectfully submitted,  
Walter STIEGLBAUER ET AL.



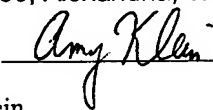
COLLARD & ROE, P.C.  
1077 Northern Boulevard  
Attorney for Applicants  
Roslyn, New York 11576  
(516) 365-9802  
EJC:ea

Elizabeth C Richter, Reg. No. 35,103  
Frederick J. Dorchak, Reg. No. 29,298  
Edward J. Callaghan, Reg. No. 46,594  
Attorneys for Applicants

Enclosure: Petition Under Rule 136(a) and 17(a)(1)

Express Mail No.: EM 171 583 850 US  
Mail Date: June 16, 2008

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10, on the date indicated above, and is addressed to the MAIL STOP: RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Amy Klein